



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Hill et al.

Serial No. 09/479,979

Filed: January 10, 2000

For: METHOD AND SYSTEM FOR
DYNAMICALLY ADAPTING THE
LAYOUT OF A DOCUMENT TO AN
OUTPUT DEVICE

Group Art Unit: 2176

Examiner: C L T Huynh

RECEIVED

AUG 26 2002

Technology Center 2100

Atty. Dkt. No. 003797.00335

REQUEST FOR RECONSIDERATION

The Honorable Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

The office action mailed May 24, 2002 has been received and its contents carefully considered. Claims 35 – 53 are currently pending in the application, claims 1 - 34 having been previously canceled.

Claims 35 - 53 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Spyglass Prism, Concepts and applications and Spyglass Prism 1.0, 3/1997 (hereinafter Spyglass) in view of Ferrel et al. U.S. Patent No. 5,860,073 (hereinafter “Ferrel”). Applicants respectfully traverse the rejection.

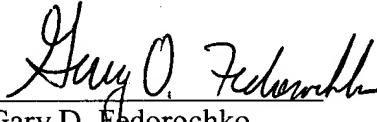
Applicants submit that Ferrel only qualifies as prior art to the instant application pursuant to 35 U.S.C. § 102(e). The effective filing date of the instant application pursuant to 35 U.S.C. § 120 is April 24, 1997. Since Ferrel and the instant application

were, at the time the claimed invention was made, owned by Microsoft Corporation, Ferrel cannot be used under 35 U.S.C. § 103 to reject the instant application. 35 U.S.C. § 103(c). For at least this reason, applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 103.

Should the Examiner apply the Spyglass Prism documents in another rejection, applicants respectfully request evidence of a specific publication date so that applicants can verify that the Spyglass Prism documents qualifies as prior art under 35 U.S.C. § 103(a). According to applicants' copy of this document, the copyright notice merely indicates that the document was published in 1997. While the action indicates that the Spyglass Prism document was published in 3/1997 and includes a press release dated March 10, 1997 announcing the debut of Spyglass Prism product on March 10, 1997, no evidence to the March date appears in applicants' copy of the documents relied on by the Examiner. Thus, applicants are unable to verify whether the Spyglass Prism document qualifies as prior art and if so, what date applicants need to show to establish a date of invention in order to swear behind the document. Moreover, applicants are unable to determine when an enabling disclosure was publicly available. The mere fact that the Spyglass Prism product was announced on March 10, 1997 does not evidence that an enabling disclosure was available to the public as of that date.

All rejections having been addressed, applicants submit that the application is in condition for allowance.

Respectfully submitted,



Gary D. Fedorochko

Registration No. 35,509

BANNER & WITCOFF, LTD.
1001 G Street, N.W., 11th Floor
Washington, D.C. 20001
(202) 508-9100
Dated: August 23, 2002